

REMARKS:

SUMMARY OF THE OFFICE ACTION AND THIS RESPONSE

In the outstanding Office Action, the Examiner has made a restriction requirement. The Applicants have made amendments to claim 29 to provide a linking claim and amended
5 claim 31 to improve readability. The applicants reserve the right to pursue the original claims 29 and 31 in a later-filed divisional application.

ELECTION/RESTRICTION

The Examiner has required restriction between group I, claims 28-31 drawn to a method,
group II, claims 1-23 drawn to a composition of matter and group III, claims 24-27 drawn
10 to a device. The Applicant submits that claim 28 properly belongs in group III. Claim 28 is a device claim dependant on claim 24. The Applicant hereby elects group II claims 1-23 with traverse.

Traverse of the restriction between groups I and II is based on the amendment of claims 29 and 31. As the Examiner has stated, according to MPEP § 806.05(f):

15 A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process.

20 The Examiner had argued that the product of claim 1 could be produced by a process that includes a step of coating one or more walls of a mesoporous template with a passive material, a process materially different from the process of claim 28. In response, the Applicant has amended claim 29 to remove the word “active” before the word “material”
25 and similarly amended claim 31. Please note that the amendments to claims 29 and 31 do not narrow any limitation of either claim within the meaning of the decision in *Festo*. Furthermore these amendments are not being made for any reason related to patentability. As a result of the amendments, the Examiner’s argument no longer applies. Therefore, the Applicant submits that claim 29 is a claim to a necessary process to making the

product of claim 1 and the restriction requirement between claims 1-23 and claims 24-28 is improper.

The Examiner states that groups III and II are related as combination and subcombination. MPEP 806.05(c)(II) states that:

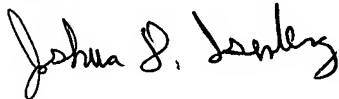
- 5 Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

10 Traverse of the restriction requirement between groups III and II is based on the Applicant's contention that the subcombination of claim 1 constitutes the essential distinguishing feature of the combination of claim 24. Specifically, the mesoporous template with material coating the walls of the pores recited in claim 1 is the essential distinguishing feature of the device of claim 24. Evidence in support for this contention can be found in the specification in the section beginning at page 7, line 31 and ending at
15 page 8, line 17.

CONCLUSION:

In view of the above amendments and remarks all restriction requirements are improper and should be withdrawn. The Applicant further submits that all pending claims are allowable over the prior art of record. Therefore, the Applicant respectfully requests that
20 the Examiner withdraw the restriction requirements, reconsider the application and issue a Notice of Allowance in the next Office Action.

Respectfully submitted,



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